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THOMPSON, JAMES A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,406

Applicant(s)

INADA, HAJIME

Examiner

James A. Thompson

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 02 July 2009 have been fully considered but they are not persuasive. Examiner agrees that the objection to claim 19 has been overcome by the present amendments to the claims. Examiner further agrees that the present amendments to the claims overcome the previously cited prior art references. However, additional prior art has been discovered which renders the presently amended claims obvious to one of ordinary skill in the art at the time of the invention. Accordingly, new grounds of rejection are set forth below. Since the new grounds of rejection have been necessitated by the present amendments to the claims, the present action is made final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 6, 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit (US-6,763,399) in view of Tomita (US-2003/0035124).

Regarding claim 1: Margalit discloses a data processing device (figure 1(10) of Margalit) having one or more functions (column 2, lines 37-44 of Margalit), the device comprising: a storing unit (figure 1(50-70) of Margalit) that stores various types of data (column 2, lines 40-43 of Margalit); a function implementing unit (figure 1(30) and column 3, lines 5-11 of Margalit); and an interface (figure 1(40) of Margalit) that is structured to be connected to both an external personal computer (figure 1(20) and column 2, lines 56-59 of Margalit) and the function implementing unit (column 2, lines 56-63 of Margalit), the function implementing unit accessing to the storing unit to read and write various types of data via the interface, and the interface allowing the external personal computer to access the storing unit to read and write the various types of data when the external personal computer is connected to the interface (column 3, lines 6-14 of Margalit - *both function implementing unit and*

external computer read and write information between each other), the storing unit being capable of being recognized, by the external personal computer, as an external storage device (column 2, lines 34-36 and lines 56-62 of Margalit - USB connected devices generally seen as external device by the computer to which they are connected), wherein the function implementing unit that, when instruction data is stored in the storing unit via the interface by the external personal computer, reads the instruction data, determines a process to implement one of the one or more functions corresponding to the read instruction data, and executes the determined process (column 2, line 63 to column 3, line 11 of Margalit).

Margalit does not disclose expressly that the function implementing unit *automatically* reads the instruction data, determines a process to implement one of the one or more functions corresponding to the read instruction data, and executes the determined process.

Tomita discloses *automatically* reading instruction data, determining a process to implement one of the one or more functions corresponding to the read instruction data, and executing the determined process (para. 100 of Tomita).

Margalit and Tomita are combinable because they are from the same field of endeavor, namely digital input data interface and processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to automatically read and execute the instruction data, as taught by Tomita. The

motivation for doing so would have been to increase processing efficiency. Therefore, it would have been obvious to combine Tomita with Margalit to obtain the invention as specified in claim 1.

Regarding claim 6: Margalit discloses expressly that when notification instruction data for requesting a notification of settings related to one of the one or more functions is stored in the storing unit, the function implementing unit stores content notification data in the storing unit indicating settings related to a function for which the notification instruction data requests notification (column 2, line 66 to column 3, line 3 of Margalit - *user data is stored along with the necessary protocol information, thus storing the needed notification data that indicates the settings related to the requested user data storage functions*).

Regarding claim 7: Margalit discloses that when the modification instruction data for requesting an update of settings related to one of the one or more functions is stored in the storing unit, the function implementing unit updates settings for a function instructed to be updated by the modification instruction data (column 2, line 66 to column 3, line 3 of Margalit - *latest version of user data is stored along with the necessary protocol information, thus storing the needed notification data that indicates the settings related to the requested user data storage functions*).

Regarding claim 19: Margalit discloses that the storing unit includes a random access memory (figure 1(60) and column 3, lines 7-11 of Margalit).

4. Claims 2, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit (US-6,763,399) in view of Tomita (US-2003/0035124) and Yoneta (US-6,359,699 B1).

Regarding claim 2: Margalit in view of Tomita does not disclose expressly an instruction data deletion commanding unit that deletes the instruction data from the storing unit after the function implementing unit implements a function indicated by the instruction data.

Yoneta discloses an instruction data deletion commanding unit that deletes the instruction data from the storing unit after the function implementing unit implements a function indicated by the instruction data (figure 8(S8-15) and column 8, lines 20-25 of Yoneta).

Margalit in view of Tomita is combinable with Yoneta because they are from similar problem solving areas, namely how to best manage information used in executing various processes, wherein said information is stored in separate memory devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to optionally delete instruction data after the instruction data is used to implement particular functions, as taught by Yoneta. The motivation for doing so would have been to keep certain information secure by allowing

the information to be used only when specifically needed. A further motivation for doing so would have been to allow an end user to use the information only to the extent that the end user has paid for access to the information. Therefore, it would have been obvious to combine Yoneta with Margalit in view of Tomita to obtain the invention as specified in claim 2.

Regarding claim 17: Margalit discloses expressly that when notification instruction data for requesting a notification of settings related to one of the one or more functions is stored in the storing unit, the function implementing unit stores content notification data in the storing unit indicating settings related to a function for which the notification instruction data requests notification (column 2, line 66 to column 3, line 3 of Margalit - *user data is stored along with the necessary protocol information, thus storing the needed notification data that indicates the settings related to the requested user data storage functions*).

Regarding claim 18: Margalit discloses that when the modification instruction data for requesting an update of settings related to one of the one or more functions is stored in the storing unit, the function implementing unit updates settings for a function instructed to be updated by the modification instruction data (column 2, line 66 to column 3, line 3 of Margalit - *latest version of user data is stored along with the necessary protocol information, thus storing the needed*

notification data that indicates the settings related to the requested user data storage functions).

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit (US-6,763,399) in view of Tomita (US-2003/0035124) and Murata (US-6,111,659).

Regarding claim 3: Margalit in view of Tomita does not disclose expressly a reading unit that implements a scanner function to read a prescribed image as image data, wherein the function implementing unit instructs the reading unit to read an image as image data when read instruction data for instructing that an image be read using the scanner function is stored in the storing unit.

Murata discloses a reading unit that implements a scanner function to read a prescribed image as image data, wherein the function implementing unit instructs the reading unit to read an image as image data when read instruction data for instructing that an image be read using the scanner function is stored in the storing unit (column 6, lines 54-58 of Murata).

Margalit in view of Tomita is combinable with Murata because they are from the same field of endeavor, namely data acquisition and storage between separate devices connected through an interface. At the time of the invention, it would have been obvious to one of ordinary skill in the art to apply the general USB key device taught by Margalit in the specific context of the digital image scanner taught by Murata. The suggestion for doing

so would have been that both devices are data acquisition devices with their own internal processors which operate under the control of external computer instructions delivered over an interface. The specific implementation in a scanner environment is simply one of the many possible ways the USB key technology taught by Margalit can be applied. Therefore, it would have been obvious to combine Murata with Margalit in view of Tomita to obtain the invention as specified in claim 3.

Further regarding claim 4: Murata discloses that the function implementing unit instructs the reading unit to read the image and produce the image data representing the image and thereafter stores the image data read by the reading unit in the storing unit (column 6, lines 54-58 of Murata).

Regarding claim 5: Margalit in view of Tomita does not disclose expressly a printing unit that implements a printer function to print an image on a printing medium based on image data, wherein the function implementing unit instructs the printing unit to print an image based on the image data when print instruction data indicating that an image be printed with the printer function and the image data are stored in the storing unit.

Murata discloses a printing unit that implements a printer function to print an image on a printing medium based on image data, wherein the function implementing unit instructs the printing unit to print an image based on the image data when print instruction data indicating that an image be printed with

the printer function and the image data are stored in the storing unit (column 6, lines 40-46 of Murata).

Margalit in view of Tomita is combinable with Murata because they are from the same field of endeavor, namely data acquisition and storage between separate devices connected through an interface. At the time of the invention, it would have been obvious to one of ordinary skill in the art to apply the general USB key device taught by Margalit in the specific context of the digital image data acquisition and printing taught by Murata. The suggestion for doing so would have been that both devices are data acquisition devices with their own internal processors which operate under the control of external computer instructions delivered over an interface. The specific implementation in a scanning and printing environment is simply one of the many possible ways the USB key technology taught by Margalit can be applied. Therefore, it would have been obvious to combine Murata with Margalit in view of Tomita to obtain the invention as specified in claim 5.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit (US-6,763,399) in view of Tomita (US-2003/0035124), Yoneta (US-6,359,699 B1), and Murata (US-6,111,659).

Regarding claim 15: Margalit in view of Tomita and Yoneta does not disclose expressly a reading unit that implements a scanner function to read a prescribed image as image data, wherein the function implementing unit instructs the reading unit

to read an image as image data when read instruction data for instructing that an image be read using the scanner function is stored in the storing unit.

Murata discloses a reading unit that implements a scanner function to read a prescribed image as image data, wherein the function implementing unit instructs the reading unit to read an image as image data when read instruction data for instructing that an image be read using the scanner function is stored in the storing unit (column 6, lines 54-58 of Murata).

Margalit in view of Tomita and Yoneta is combinable with Murata because they are from the same field of endeavor, namely data acquisition and storage between separate devices connected through an interface. At the time of the invention, it would have been obvious to one of ordinary skill in the art to apply the general USB key device taught by Margalit in the specific context of the digital image scanner taught by Murata. The suggestion for doing so would have been that both devices are data acquisition devices with their own internal processors which operate under the control of external computer instructions delivered over an interface. The specific implementation in a scanner environment is simply one of the many possible ways the USB key technology taught by Margalit can be applied. Therefore, it would have been obvious to combine Murata with Margalit in view of Tomita and Yoneta to obtain the invention as specified in claim 15.

Regarding claim 16: Margalit in view of Tomita and Yoneta does not disclose expressly a printing unit that implements a printer function to print an image on a printing medium based on image data, wherein the function implementing unit instructs the printing unit to print an image based on the image data when print instruction data indicating that an image be printed with the printer function and the image data are stored in the storing unit.

Murata discloses a printing unit that implements a printer function to print an image on a printing medium based on image data, wherein the function implementing unit instructs the printing unit to print an image based on the image data when print instruction data indicating that an image be printed with the printer function and the image data are stored in the storing unit (column 6, lines 40-46 of Murata).

Margalit in view of Tomita and Yoneta is combinable with Murata because they are from the same field of endeavor, namely data acquisition and storage between separate devices connected through an interface. At the time of the invention, it would have been obvious to one of ordinary skill in the art to apply the general USB key device taught by Margalit in the specific context of the digital image data acquisition and printing taught by Murata. The suggestion for doing so would have been that both devices are data acquisition devices with their own internal processors which operate under the control of external computer instructions delivered over an interface. The specific

implementation in a scanning and printing environment is simply one of the many possible ways the USB key technology taught by Margalit can be applied. Therefore, it would have been obvious to combine Murata with Margalit in view of Tomita and Yoneta to obtain the invention as specified in claim 16.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A.

Thompson whose telephone number is (571)272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A Thompson/
Primary Examiner
Art Unit 2625

16 August 2009